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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,550	03/13/2002	Takashi Gojobori	033808-282106	6662

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EXAMINER

LIN, JERRY

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,550

Applicant(s)

GOJOBORI ET AL.

Examiner

Jerry Lin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 5-7, 14, 15 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 5-7, 14, 15 and 23 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Applicant has cancelled claims 1-2, 4, 8-13, and 16-22.  
Claims 3, 5-7, 14, 15, and 23 are pending.

### ***Response to Amendment***

2. The declaration under 37 CFR 1.132 filed July 14, 2004 is insufficient to overcome the rejection of all the claims based upon 35 U.S.C. 112, second paragraph or of claim 3 based upon 35 U.S.C. 102(b) as set forth in the last Office action for the reasons cited in this action below.

The declaration refers only to the system described in instant application and not to the individual claims of the application. As such, the declaration does not show that the objective evidence of novelty is commensurate in scope with the claims. See MPEP § 716.

### ***Claim Objections***

3. Claim 15 objected to because of the following informalities: The word "of" is missing in the last line of the claim between "respect" and "gene". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 5-7, 14, 15, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to all claims, the phrase "memorizing means" is indefinite as to whether it refers to a database, a computer memory, a removable memory storage device, etc. It is unclear what is encompassed since the term is not a standard term used in the art. Although the submitted declaration by Dr Takashi Gojobori does mention some "memorizing means" such as a database, it is still unclear whether "memorizing means" is limited to databases or other types of data storage.

With regard to all claims, the phrase "setting a viewpoint" is indefinite as to whether it involves entering numerical coordinates, or whether the user clicks on a position within the visual image display using a computer mouse, etc.

In claims 5, 14, and 15, the phrase "in a predetermined display format" is indefinite as to what types of display formats are encompassed.

This rejection is maintained from the first Office Action.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Hartenstein et al. (*Trends in Genetics*, 1995).

Please see the previous office action for the teachings of Hartenstein et al.

Applicant responded to this rejection by indicating that the instant claim displays changes in shape as a result of internal activities and external stimulation. Since the instant claim may display changes resulting from external stimulation, the instant claim displays the actual result of planned experiments. Applicant contends that this aspect distinguishes the instant claim from Hartenstein et al.

The Examiner respectfully disagrees with the Applicant's distinction between natural phenomena and planned experiments. Natural phenomena include both external stimulation as well as internal activities. In the case of embryogenesis, several intercellular proteins, like the hedgehog family, are involved in cellular differentiation, tissue patterning, and cell positional information. The external stimulation from hedgehog proteins results in changes in embryogenesis. Although embryogenesis is a natural phenomenon, both external stimulation and internal activities are present in the cells.

The claim as written does not distinguish between natural phenomena or planned experiments. Nor does the instant claim limit itself to planned experiments. The instant claim displays changes from any external stimulation or internal activity, whether natural

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or planned. Thus, rejection of claim 3 under 102(b) is maintained as being anticipated by Hartenstein et al.

The declaration filed on July 14, 2004 under 37 CFR 1.132 has been considered but is ineffective to overcome the Hartenstein et al. reference for Claim 3. The declaration only gives embodiments of the claimed invention. The claims are much broader than the declaration. The claims encompass both the Hartenstein et al. reference as well as the embodiment outlined in the declaration.

This rejection is maintained from the first Office Action.

#### ***Status of Previous Rejections or Objections***

8. Any objections or rejections cited in previous actions and not cited in the present action are withdrawn.

#### ***Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL  
September 23, 2004

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
